

REMARKS

This Amendment Under 37 C.F.R. § 1.111 is prepared in accordance with the waiver of 37 C.F.R. § 1.121(a), (b), (c) and (d) as interpreted by the Office Of Patent Legal Administration.

I. Status Of Claims

Claims 1, 16, 18, 23, 29, 35, 36 and 43 are the current independent claims of this application. Independent claims 1, 16, 23, 29, 35 and 36 have been amended to recite:

... said polymerization catalyst having a substituted hydrocarbon group having a carbon number of more than 10, or a nonsubstituted hydrocarbon group having a carbon number of more than 10, or a cyclic organic structure having a more than 10 carbon number hydrocarbon group.

Allowable Subject Matter

The Examiner indicates that claim 18 would be allowable if re-written in independent form including all of the limitations of the base claim and any intervening claims (*see* Office Action, on page 10).

Original claim 18 is dependent on claims 16 and 17. In accordance with the Examiner's suggestion claim 18 has been rewritten in independent form and further divided into two claims (i.e. claims 18 and 43) to account for the multiple dependency (on claims 16 or 17). Amended independent claim 18 includes recitations of independent claim 16 and claim 18. New independent claim 43 includes recitations of claims 16, 17 and 18. Both, independent claim 18 and new independent claim 43 are independent forms capturing the allowable scope of original claim 18.

II. Priority

Applicants thank the Examiner for the courtesy extended to their undersigned representative during a telephonic conversation on, or about, May 27, 2003, regarding the Examiner's request for a certified copy of JP-11/359391 ('391). Applicants' copy of the PCT/IB/304 (submitted herewith for the Examiner's convenience in Appendix A) indicates that the certified copy of '391 was submitted or transmitted to the U.S.P.T.O. Applicant acknowledges the Examiner's explanation that the International Bureau provided two copies of one priority document and no copy of '391. Applicants request the Examiner's assistance in resolving this matter.

III. Claim Objections

Claims 4-15, 19-22, 26-28, 31-34 and 38-42 are objected to under 37 C.F.R. §1.75(c) as being in improper form and have not been further treated on the merits. Applicants' amended claims are properly dependent.

Claims 6, 7, 9, and 10 stand objected to because the claims contained multiple periods. Applicants' amended claims do not contain multiple periods.

Applicants appreciate the Examiner's claim language suggestion. These suggestions have been amended, as appropriate, in claims 2, 15, 18, 22, 24, 32, 35, 36, 37, 38, and 42.

IV. Claim Rejections Under 35 U.S.C. §102

Claim 1-3, 16-17, 23-25, 29-30, 35-37 are rejected under 35 U.S.C. §102(e) as being anticipated by Ikushima *et al.* (U.S. Pat. No. 6,015,848; "848").

Applicants respectively traverse.

As discussed *supra*, independent claims 1, 16, 23, 29, 35 and 36 have been amended to recite:

... said polymerization catalyst having a substituted hydrocarbon group having a carbon number of more than 10, or a nonsubstituted hydrocarbon group having a carbon number of more than 10, or a cyclic organic structure having a more than 10 carbon number hydrocarbon group.

Applicants assert the catalysts of '848 have short alkyl chains (with a carbon number of approximately 10 or less). Accordingly, the '848 catalysts do not possess the reversible property claimed by Applicants of dissolving and crystallizing in an epoxy resin. No such characteristics are disclosed in '848 as claimed by Applicants.

A distinguishing characteristic of the present invention is that it can be reversibly dissolved and crystallized by heating and cooling. The catalysts form a colloid or a micelle, and a crystal in an epoxy compound and/or an acrylic resin because of the long alkyl chains as claimed by Applicants. Further, an active position in the catalyst may be a state existing apart (isolated) from the epoxy compound and/or the acrylic resin, as described in the specification (page 34). Applicants assert that such characteristic is not taught by '848.

The Examiner notes that '848 discloses "can be dissolved by heating or crystallized by cooling (column 6, lines 44-57 and column 7, lines 15-20)" (*see* Office Action, on page 7). This statement is distinguished by '848 in its text where it is disclosed that Component (C) catalyst is "... inactive at ordinary temperatures but, when heated to reach the critical temperature, causes cleavage to generate a cation and give rise to cationic polymerization" (column 6, lines 44-57). Thus, '848 teaches away from "can be dissolved by heating or crystallized by cooling" as claimed in the present invention.

CONCLUSION

Based on the foregoing amendments and remarks, Applicants respectfully assert that '848 does not disclose all of the claimed elements of Applicants' claimed invention. Therefore, Applicants respectfully request that the rejection of claims 1-3, 16-17, 23-25, 29-30, 35-37 under 35 U.S.C. §102(e) be withdrawn. In view of the above, Applicants also respectfully request that all objections to the claims be withdrawn. Applicants respectfully assert that all pending claims are allowable and request reconsideration and the allowance of this application.

AUTHORIZATION

The Commissioner is hereby authorized to charge any additional fees which may be required for the timely consideration of this amendment, or credit any overpayment, to Deposit Account No. 13-4500, Order No. 1776-4067. A DUPLICATE COPY OF THIS SHEET IS ATTACHED.

Respectfully submitted,
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(PCT Administrative Instructions, Section 411)

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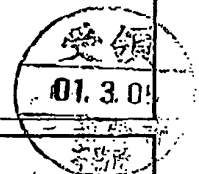
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Date of mailing (day/month/year) 23 February 2001 (23.02.01)	
Applicant's or agent's file reference FDA-201PCT	IMPORTANT NOTIFICATION
International application No. PCT/JP00/08906	International filing date (day/month/year) 15 December 2000 (15.12.00)
International publication date (day/month/year) Not yet published	Priority date (day/month/year) 17 December 1999 (17.12.99)
Applicant DAICEL CHEMICAL INDUSTRIES, LTD. et al	

1. The applicant is hereby notified of the date of receipt (except where the letters "NR" appear in the right-hand column) by the International Bureau of the priority document(s) relating to the earlier application(s) indicated below. Unless otherwise indicated by an asterisk appearing next to a date of receipt, or by the letters "NR", in the right-hand column, the priority document concerned was submitted or transmitted to the International Bureau in compliance with Rule 17.1(a) or (b).
2. This updates and replaces any previously issued notification concerning submission or transmittal of priority documents.
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<u>Priority date</u>	<u>Priority application No.</u>	<u>Country or regional Office or PCT receiving Office</u>	<u>Date of receipt of priority document</u>
17 Dec 1999 (17.12.99)	11/359235	JP	12 Febr 2001 (12.02.01)
17 Dec 1999 (17.12.99)	11/359307	JP	12 Febr 2001 (12.02.01)
17 Dec 1999 (17.12.99)	11/359343	JP	12 Febr 2001 (12.02.01)
17 Dec 1999 (17.12.99)	11/359369	JP	12 Febr 2001 (12.02.01)
17 Dec 1999 (17.12.99)	11/359391	JP	12 Febr 2001 (12.02.01)



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